

REMARKS:

Claims 1 and 3-11 are in the case and presented for consideration.

Claim 2 is cancelled.

Claims 1 and 11 are currently amended to include the language of claim 2.

Claims 1, 7 and 11 are amended to include the language "of channels" to clarify the language of each respective claim.

Claims Rejection under 35 U.S.C. § 103

Claims 1-3 and 7-11 have been rejected by the Examiner as being unpatentably obvious over United States Patent No. 5,805,230 to Staron (Staron) in view of United States Patent Application Publication No. 2006/0206912 to Klarfeld et al. (Klarfeld et al.). The reasons for the Examiners rejection are stated on pages 2-5 of the Office Action dated October 31, 2007 (Office Action). Applicant respectfully requests reconsideration of the rejection in light of the amendment to claim 1 and in consideration of the argument below.

Claim 1:

Neither Staron nor Klarfeld et al. disclose, alone or in combination, the claimed element of "installing, of all channels available in a broadcast network, only a subset that meets the user interest profile" where the user interest profile is based on at least one preference in the language of the channel and/or the type of channel. To understand why, one has to examine carefully the language of the claim, specifically the

use of the word “installing” as used within the context of the disclosure and as commonly understood in the art.

The plain and ordinary meaning of the word “installing” means, “to set up for use or service” (see install - Definition from the Merriam-Webster Online Dictionary. <http://m-w.com/dictionary/install> (Accessed January 25, 2008)). This method includes the steps of determining a user interest profile based on at least one category of preference in the language and/or type of channel and **installing only a subset of channels** that meet the user’s interest profile from a pool of all available channels. That is, in order for the installation of the subset to meet the user interest profile as claimed, the user interest profile must already exist (i.e., a user interest profile is necessarily and inherently determined **before** the installation of the subset of channels based; it is implicit in the language of claim 1 that determining a user interest profile is achieved before installing a channel subset that *meets the user interest profile*).

In the state of the art prior to the present application, channels were installed indiscriminately, having no regard for such preferences of the user and using up a considerable amount of local storage capacity in the process. Various schemes were developed for creating a profile used to select, from among **all** programs available on **all** channels, only those that meet an interest of the user using adaptive and automatic learning algorithms. However, this is accomplished by installing **all** of the channels indiscriminately and only **after** the installation assisting the user in managing this pool of channels by removing or hiding unwanted channels. Such a scheme is disclosed in the Klarfeld reference. The scheme disclosed in the Klarfield reference (i.e., creating a profile

to remove or hide unwanted channels **after** the installation) is in stark contrast to determining a user interest profile **before** the installation of the subset of channels, as implicitly claimed in claim 1.

Referring to Fig. 2 of the Klarfeld et al. reference we see that both the program content and the program information are transmitted along with parameters describing population viewing habits to the user's receiver (Klarfeld et al., page 7, paragraphs [0108] and [0109]). Examples of the preference determination parameters include: (i) the traits which are exhibited by each program and the degree to which such a trait is exhibited and (ii) a distribution list of the liking values amongst the viewing population of each trait (Klarfeld et al., page 7, paragraph [0108]). From this disclosure one can readily discern that there is no consideration as to the end user's own unique preferences **prior** to receiving the information from the broadcast network. **All** of the relevant traits for **all** of the relevant channels are provided to the user in the Klarfeld reference, to be sorted through **after** the data has been received. This is to say that Klarfeld speaks only to post-installation screening to accommodate the end-user while the present Application stands for accommodating the end-user with a pre-installation screening process.

To establish a *prima facie* case of obviousness, the Examiner must expressly demonstrate a common-sense rationale to modify the reference as he has suggested. He should also show that his suggested modification of the prior art was reasonably expected to succeed, and that the prior art reference teaches or suggests all of the claim limitations. See, e.g., *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Royka*, 490

F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *KSR Int'l Co. v. Teleflex, Inc.* 127 S.Ct. 1727 (2007) ("There is no necessary inconsistency between the idea underlying the TSM test and the Graham analysis"). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007).

As discussed above, the Klarfeld et al. reference applies only to modifying user interest profiles **post-installation**. As such, the Examiner's proposed modification of Staron with Klarfeld would change the principle of operation of the prior art invention to cover the method of the present application, which is a **pre-Installation** screening process. Such a modification would not be obvious to one in ordinarily skilled in the art and therefore cannot be advanced by the Examiner to establish his *prima facie* case for an obviousness rejection.

Turning now to the Staron reference, we see that it is silent with respect to the claimed elements of determining a user interest profile based upon the preference of channel language and/or channel type. Rather, Staron discloses an automatic programming method for a television tuner based only on geographical location (summary

of invention). This geographical data is then used to automatically choose from a table of channels, each table corresponding to a ZIP code, based upon which channels provides the best reception (Staron, col. 3, lines 1-20). In short, Staron discloses installing **all** of the available channels for a particular broadcasting network with the best reception according to ZIP code. The automatic pre-selection of channels disclosed in Staron is based on the completely objective reference of channel level given by the automatic gain control circuit of the tuner (Staron, col. 3, lines 13-16). As such, a user's unique and personal preference for a given language or channel type is not a factor considered by the Staron reference. In sharp contrast stands the present Application wherein, since the channel type and language are subjective preferences, the means of pre-selection cannot be automated but rather requires user interaction as, for instance, a user interface (Fig. 2, 230) or through customer service or over the Internet (see specification, paragraph [0027] as means to implement the user interest profile determining step of claim 1 of the Application).

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole" as does disregarding the limitations of an application. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Because the installation of only a subset of channels based on the user interest profile of claim 1 requires **active user input** to **subjectively** select a subset of channels from all available channels **before installation** the subject matter of the Application, "as a whole", is patentably distinct from the Staron reference, which teaches **automating** the selection of one **objective** feature of a channel without regard to the subjective tastes of the user. As

such, the Staron reference does not teach or suggest, alone or in combination with Klarfeld et al., all the limitations as recited in claims 1 of the present application and so cannot be used as reference to support a *prima facie* showing of obviousness in this matter. Neither are all the limitations recited in claim 1 inherent or implied in either of the references cited by the Examiner.

Based on the foregoing, Staron and Klarfeld et al. cannot provide one of ordinary skill in the art with the necessary motivation to produce the claimed invention. Independent claims 1 and 11 are, therefore, believed to recite patentable subject matter, and their allowance is respectfully requested. Claims 3 and 7-10 depend from claims 1, and are also allowable for the same reasons given above for claim 1.

Dependent claims 4-6, further define the invention in a manner that is believed to even better distinguish the claimed invention over the prior art so that allowance of these claims is also respectfully requested.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,

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